

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1, 3-16, 18-31, 33-69, and 71-87 are currently pending in the instant application. Claims 1, 16, 31, 69, 77, 78 and 87 are independent. By this Amendment, Applicants have added new claim 87. Applicants submit that support for the Amendment may be found throughout the specification and originally-filed claims, and that no new matter has been added.

Rejections under 35 U.S.C. § 101

Claims 77-78 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because the claims "don not recite any application or use of the technological arts." Applicants respectfully traverse this rejection in view of the recent board decision in *In re Lundgren*, Appeal No. 2003-2088 (BPAI 2005). Specifically, the Board held that

there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

Id. at 7. In view of *Lundgren*, Applicants respectfully request that this rejection be withdrawn.

Rejections under 35 U.S.C. § 103

In the Office Action dated September 15, 2005, the Examiner rejected claims 1, 3, 12-16, 18, 20-21, 25-26, 28, 30-31, 33, 35, 47, 49, 51-53, 55, 57, 60, 67, 69, 71, and 74-76 under 35 U.S.C. § 103(a) as being obvious over De Tore et al. (4,975,840), in view of Seare et al. (6,223,164) further in view of Joao (6,283,761). Applicants

respectfully submit the cited reference fails to disclose or suggest each of the limitations of the pending claims.

For example, new independent claim 87 recites, *inter alia*:

A method for assessing insurance ...comprising:

- a) connecting to one or more databases comprising:
 - i) a multiple-level hierarchical model of the human body, ... wherein each body part has associated component functionality values that indicate the body parts' importance to each of the one or more other body parts of which the body part is a component; and
 - ii) a plurality of medical condition profiles each medical condition profile associating a transient medical condition, one or more body parts affected by the transient medical condition and one or more temporally variable dysfunction values indicating the relative affect of the transient medical condition on each of the one or more body parts over a range of times;

* * *

- e) generating a first capacity level for each of the one or more body parts of identified in (d, i) based on the associated temporally variable dysfunction value identified in (d, ii);
- f) generating a second capacity level for any of the body parts identified in (d, iii) based on the capacity levels generated in (e) and the associated component functionality values; and
- g) generating and outputting an insurance compensation value based on the results of steps (e) and/or (f).

None of the cited references disclose, *inter alia*, a database comprised of medical condition profiles and associated temporally variable dysfunction values, which are used to determine compensation for a disability insurance claim. DeTore et al., for example, is directed to determining the appropriate premium price for a particular individuals insurance policy. It is not directed to the payment of insurance claims. Seare et al. is directed to determining the appropriate cost of particular medical treatments and, therefore, does not disclose or require a determination of a patient's dysfunction level for

a particular body part over a range of times. Joao is an overarching system for processing healthcare information and does not disclose temporally variable dysfunctions values describing the level of dysfunction of a body part over a range of times due to a particular medical condition.

Similarly, in response to reasons for patentability supplied in Applicants' previous Amendment and Response, the Examiner has not expressly explained how the prior art discloses a profile estimating the body part's level of dysfunction over a particular time frame after an injury. The Examiner now cites to Joao (col. 27, lines 9-30) for that disclosure. The passage of Joao, however, relates to a mechanism to double check that a patient does not undergo surgery on the wrong body part due to a clerical error. Applicants submit that this does not teach or suggest a profile that indicates an estimated level of dysfunction of a particular body part over a time frame. To the extent that the Examiner intends to maintain this rejection, Applicants respectfully request that the Examiner explain how the cited passage of Joao makes the purported disclosure.

In rejecting Applicants' argument that the cited art does not disclose the (1) dysfunction of individual body parts, (2) estimates of their progressive recovery rate over time in the future, or (3) representation of injury and estimate of future recovery as dysfunction levels over time, the Examiner has cited a passage from Joao stating "a method for providing healthcare information which can be utilized to find and/or supplies, body organ, blood, medications, and/or any other goods, products and/or supplies, etc." (Jaoa col. 10, lines 3-29). Applicants respectfully submit that locating body organs, blood, etc. is unrelated to Applicants' claimed invention and articulated

arguments. Disclosure of a method for locating medical supplies does not teach or suggest Applicants' claimed system for establishing the level of dysfunction of a particular body part in a disability insurance compensation system.

Based on the foregoing it is the position of the Applicants that the Examiner has failed to provide a *prima facia* case of obviousness. Accordingly, Applicants respectfully request that these rejections be clarified or withdrawn.

Conclusion

For the reasons set forth above, Applicants respectfully request the rejections of Claims 1, 3-16, 18-31, 33-69, and 71-87 be withdrawn and submit that each of the pending claims are in condition for allowance.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 12941.200.

In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 12941.200.

Respectfully submitted,
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